UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ABRISHAMKAR, KAVEH

ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/938,023	BUCHHEIT ET AL.
Office Action Summary	Examiner	Art Unit	
	Kaveh Abrishamkar	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _04 April 2005_.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _13-34_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _13-34_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on April 4, 2005. Claims 13-34 were previously presented for examination. Per the received amendment, claims 13,14, 21, and 31 are currently amended. Claims 13-34 are currently being considered.

Response to Arguments

2.   The applicant's arguments received on April 4, 2005, have been fully considered but they are not considered persuasive because:

Regarding amended claim 13, the applicant argues that the cited prior art, Cohen (U.S. Patent 6,233,567), does not teach "encoding of software dependent on a secret firm key (FK) freely selected by the licenser." This argument is not found persuasive. The CPA discloses that if "client system 50 has detected that registration key (T) is not received from vendor system 80 or is not valid, any functionality of software 72 that is not accessible to non-paid users remain locked or hidden"(column 6 lines 34-37). This registration key can be interpreted as the secret Firm Key (FK) that enables the functioning of the software. Furthermore, the applicant argues that the CPA does not teach "encoding of the software dependent on the secret firm key (FK) freely selected by the licenser." This argument is not found persuasive. As mentioned above, the registration key is need to decode or enable the utility of the software, so the encoded software is dependent on the registration key (secret firm key). Furthermore, the

applicant argues that the CPA does not teach "encoding of the transmission of the

license parameters dependent in a secret Private Serial Key (SK) generated at the

licensee's site." The CPA discloses that the registration code is encrypted along with the

unique machine identifier (column 5 lines 40-53). Regarding dependent claim 14, the

applicant argues that the CPA does not teach "the secret Private Serial Key (SK) is

produced randomly at the licensee without a person being able to influence such

production." The CPA discloses a private key which is generated randomly and is used

to encrypt the registration code (license parameters) (column 3 lines 28-67, column 5

lines 35-57). Furthermore, the applicant argues that the CPA does not teach a

"signature of the transmission of the license parameters from said licenser to said

licensee occurs dependent on a unique Serial Number (SN). The CPA discloses that

there is a "one-way hashed machine identifier with private user data appended" (column

5 lines 40-53). This one-way hash is analogous to a signature, and since the machine

identifier is a license parameter, it is believed that this limitation is taught. Furthermore,

the applicant argues that the CPA does not teach assigning a secret firm common key

(FCK) produced from a common key (CK) through encoding dependent on the firm code

(FC) of the licenser and that the changing or deletion of the license parameters occurs

dependent on the FCK. The license parameters are encrypted in the CPA (column 5

lines 35-56), with a private key (FCK) which can be formed in any way, including using a

common key (CK), and therefore, the only way to access the parameters to change

them is by using the private key (FCK) which would allow deletion of the parameters.

The applicant further argues that the CPA does not teach "the storage of the license

parameters occurs within a protective device developed as a hardware supplement" as disclosed in claim 17. This argument is not found persuasive. A protective device is a broad term and is disclosed by the CPA. The CPA disclose a "registration storage unit" (column 6 lines 11-20) where the registration key is only accessed when needed. The protective device can be interpreted as the client system. Furthermore, the applicant argues that the CPA does not teach decoding the software by means of a decoder as disclosed in claim 18. This argument is not found persuasive. The client system has a function of decrypting (decoding) the registration key (column 6 lines 11-33). Furthermore, the applicant argues that the CPA does not teach "a limiter secure against manipulation that limits the time period and/or the number of decodings of the protected software" in claim 19. However, the CPA discloses if "the client system 50 has detected that registration key (T) is not received from the vendor system 80 or is not valid, any functionality of software 72 that is not accessible to non-paid users remain locked or hidden" (column 6 lines 20-38). In this case, the number of decodings is zero and therefore is locked from access if a valid key is not present. Regarding claim 30, the applicant argues that the CPA does not teach "the encoding of license parameters between the licenser and the licensee dependent on the private box key." This argument is not found persuasive. The CPA discloses that the registration code is encrypted along with the unique machine identifier (column 5 lines 40-53). Regarding amended claim 31, the applicant argues that the CPA does not teach "an encoder and decoder connected to an interface for connection with a computer of said licensee." However, an interface is a broad term which is interpreted as having a capability to

connect. The CPA does teach the encrypting and decrypting of license parameters

which are sent from licenser to licensee (Figure 1 item 97, item 98). Therefore, it is

interpreted as having an interface for the connections with a computer of a licensee.

Therefore, the rejection for the claims 13-34 is respectfully maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 13 – 34 are rejected under 35 U.S.C. 102(e) as being anticipated by

Cohen (U.S. Patent 6,233,567).

Regarding claim 13, Cohen discloses:

A procedure for the protection of computer software and/or computer-readable

data against unauthorized use, including the steps of:

encoding of software or data by a licenser dependent on license parameters

containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated

by said licenser of the software or the data, which together initiate the encoding (column

3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1

item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to

said licensee (column 6 lines 1 – 37);

storing the license parameters in a nonvolatile memory of said licensee (Figure 4

item 120, column 6 lines 11 – 20);

automatically decoding the software or data by means of a decoder dependent

on the storage license parameters during the use of the software or data by said

licensee wherein:

encoding of software or data is initialized dependent on a secret Firm Key (FK)

freely selected by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6

line 19);

the encoding of the transmission of the license parameters occurs dependent on

a secret Private Serial Key (SK) generated at said licensee (column 2 lines 35 – 49,

column 6 lines 1 – 37); and

the decoding of the software or data is initialized dependent on the Firm Key (FK)

selected by said licenser (column 5 line 28 – column 6 line 37).

Regarding claim 25, Cohen discloses:

A procedure for the protection of computer software and/or computer-readable

data against unauthorized use, including the steps of:

encoding of software or data by a licenser dependent on a license parameters

containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated

by said licenser of the software or the data, which together initiate the encoding (column

3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1

item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to

said licensee (column 6 lines 1 – 37);

automatically decoding the software or data by means of a decoder dependent

on the license parameters during the use of the software or data by said licensee

(column 5 line 28 – column 6 line 37);

initializing encoding of software or data dependent on the Firm Key (FK) selected

by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6 line 19);

encoding of the transmission of the license parameters dependent on a secret

Private Serial Key (SK) (column 2 lines 35 – 49, column 6 lines 1 – 37);

initializing decoding of the software or data dependent on the Firm Key (FK)

selected by said licenser (column 5 line 28 – column 6 line 37);

producing the secret Private Serial Key (SK) randomly at said licensee (column 2

lines 35 – 49, column 6 lines 1 – 37); and

storing the license parameters within a memory of a protective device (Figure 4

item 120, column 6 lines 11 – 20).

Regarding claim 31, Cohen discloses:

A protective device for use in a procedure which includes:

encoding of software or data by a licenser dependent on license parameters

containing a Firm Code (FC) assigned to said licenser and a User Code (UC) allocated

by said licenser of the software or the data, which together initiate the encoding (column

3 lines 28 – 67, column 5 line 28 – column 6 line 19);

storing the encoded software or data on a data medium of a licensee (Figure 1

item 72, column 3 lines 65 – 67);

sending an encoded transmission of the license parameters from said licenser to

said licensee (column 6 lines 1 – 37);

automatically decoding the software or data by means of a decoder dependent

on the license parameters during the use of the software or data by said licensee

(column 5 line 28 – column 6 line 37);

initializing encoding of software or data dependent on a secret Firm Key (FK)

freely selected by said licenser (column 3 lines 28 – 67, column 5 line 28 – column 6

line 19);

encoding the transmission of the license parameters dependent on a secret

Private Serial Key (SK) (column 2 lines 35 – 49, column 6 lines 1 – 37); and

initializing the decoding of the software or data dependent on the Firm Key (FK)

selected by said licenser (column 5 line 28 – column 6 line 37), said protective device

comprising:

an interface for connection with a computer of said licensee (Figure 1 items 82

and 54);

a microprocessor (Figure 1 item 84);

a nonvolatile memory in which the license parameters are stored (Figure 4 item

120, column 6 lines 11 – 20);

an encoder and decoder connected to said interface for the automatic decoding

of the software or data dependent on the stored license parameters (Figure 1 item 97,

item 98, column 5 line 28 – column 6 line 37); and

an installation for the production of a random secret Private Serial Key (SK) for

the encoding of the transmission of the license parameters between said licenser and

said licensee (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 14 is rejected as applied above in rejecting claim 13. Furthermore, Cohen

discloses:

A procedure in accordance with claim 13, wherein:

the secret Private Serial Key (SK) is produced randomly, at said licensee without

a person being able to influence such production (column 2 lines 35 – 49, column 6

lines 1 – 37).

Claim 15 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim1 3, wherein:

the signature of the transmission of the license parameters from said licenser to said licensee occurs dependent on a unique Serial Number (SN) firmly assigned to said licensee (column 2 lines 50 – 55, column 4 lines 1 – 8).

Claim 16 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim 13 wherein:

said licenser is assigned a secret Firm Common Key (FCK), which is produced from a Common Key (CK) through encoding dependent on the Firm Code (FC) of said licenser (column 6 line 63 – column 7 line 8); and

the installation, changing, or deletion of the license parameters occurs dependent on the Firm Common Key (FCK) (column 6 line 63 – column 7 line 8).

Claim 17 is rejected as applied above in rejecting claim 13. Furthermore, Cohen discloses:

A procedure in accordance with claim 13 wherein:

the storage of the license parameters occurs within a protective device developed as a hardware supplement ((Figure 4 item 120, column 6 lines 11 – 20).

Claim 21 is rejected as applied above in rejecting claim 13. Furthermore, Cohen

discloses:

A protective device for use in a procedure in accordance with claim 13,

comprising:

an interface for connection with a computer of said licensee (Figure 1 items 82

and 54);

a microprocessor (Figure 1 item 84);

a nonvolatile memory in which the license parameters are stored (Figure 4 item

120, column 6 lines 11 – 20); and

an encoder and decoder connected to said interface for the automatic decoding

of the software or data dependent on the store license parameters (Figure 1 item 97,

item 98); and

an installation for the production of a random secret Private Serial Key (SK) for

the encoding of the transmission of the license parameters between said licenser and

said licensee (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 26 is rejected as applied above in rejecting claim 25. Furthermore, Cohen

discloses:

A procedure in accordance with claim 25, wherein:

the signature of the transmission of the license parameters from said licenser to

said licensee occurs dependent on a unique Serial Number (SN) firmly assigned to said

licensee (column 2 lines 50 – 55, column 4 lines 1 – 8).

Claim 27 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

said licenser is assigned a secret Firm Common Key (FCK), which is produced from a Common Key (CK) through encoding dependent on the Firm Code (FC) of said licensee (column 6 line 63 – column 7 line 8); and

the installation, changing, or deletion of the license parameters occurs dependent on the Firm Common Key (FCK) (column 6 line 63 – column 7 line 8).

Claim 28 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

the automatic decoding of the protected software or data occurs by means of an encoder and decoder arranged within the protective device (column 5 line 28 – column 6 line 37).

Claim 29 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

the protective device contains a limiter secure against manipulation that limits the time period and/or the number of decodings of the protected software of the protected software or data (column 7 lines 8 – 30).

Claim 30 is rejected as applied above in rejecting claim 25. Furthermore, Cohen discloses:

A procedure in accordance with claim 25 wherein:

a secret Private Box Key (BK) determined by a producer is stored in the protective device (column 2 lines 35 – 49, column 6 lines 1 – 37); and

the encoding of the transmission of the license parameters between said licenser and the licensee occurs dependent on this Private Box Key (BK) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 32 is rejected as applied above in rejecting claim 31. Furthermore, Cohen discloses:

A protective device in accordance with claim 31, wherein:

the memory includes several memory areas for the storage of license parameters of different licensers (Figure 4 item 120, column 6 lines 11 – 20).

Claim 33 is rejected as applied above in rejecting claim 31. Furthermore, Cohen discloses:

the microprocessor, the memory, the encoder/decoder, and the installation for

the production of the Private Serial Key (SK) are developed on a single integrated

semiconductor circuit (ASIC) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 34 is rejected as applied above in rejecting claim 31. Furthermore, Cohen

discloses:

A protective device in accordance with claim 31 including:

a limiter secure from manipulation that limits the time period and/or the number of

decodings of the protected software or data (column 7 lines 8 – 31).

Claim 18 is rejected as applied above in rejecting claim 17. Furthermore, Cohen

discloses:

A procedure in accordance with claim 17 wherein:

the automatic decoding of the protected software or data occurs by means of an

encoder and decoder arranged within the protective device (column 5 line 28 – column

6 line 37).

Claim 19 is rejected as applied above in rejecting claim 17. Furthermore, Cohen

discloses:

A procedure in accordance with claim 17 wherein:

the protective device contains a limiter secure against manipulation that limits the

time period and/or the number of decodings of the protected software or data (column 7

lines 8 – 31).

Claim 20 is rejected as applied above in rejecting claim 17. Furthermore, Cohen

discloses:

A procedure in accordance with claim 17 wherein:

a secret Private Box Key (BK) determined by a producer is stored in the

protective device (column 2 lines 35 – 49, column 6 lines 1 – 37); and

the encoding of the transmission of license parameters between said licenser

and the licensee occurs dependent on this Private Box Key (BK) (column 2 lines 35 –

49, column 6 lines 1 – 37).

Claim 22 is rejected as applied above in rejecting claim 21. Furthermore, Cohen

discloses:

A protective device in accordance with claim 21, wherein:

the memory includes several memory areas for the storage of license parameters

of different licensers (Figure 4 item 120, column 6 lines 11 – 20).

Claim 23 is rejected as applied above in rejecting claim 21. Furthermore, Cohen

discloses:

A protective device in accordance with claim 21 wherein:

the microprocessor, the memory, the encoder/decoder, and the installation for

the production of the Private Serial Key (SK) are developed on a single integrated

semiconductor circuit (ASIC) (column 2 lines 35 – 49, column 6 lines 1 – 37).

Claim 24 is rejected as applied above in rejecting claim 21. Furthermore, Cohen

discloses:

A protective device in accordance with claim 21 including:

a limiter secure from manipulation that limits the time period and/or the number of

decodings of the protected software or data (column 7 lines 8 – 31).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA
06/23/2005

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